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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,186	10/12/2001	Felix G.T.I. Andrew	13768.783.9	1415

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EXAMINER

HANNE, SARA M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/976,186

Applicant(s)

ANDREW, FELIX G.T.I.

Examiner

Sara M. Hanne

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment received on October 4, 2006.

Claims 1-26 are pending in the application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The "computer-readable medium" as stated in these claims is defined by the specification as a modulated signal or carrier wave (page 8, line 21 et seq.), which is nonstatutory. See MPEP 2106.01 [R-5].

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically the amendments to Claims 1, 11, 14 and new Claim 25: "prior to receiving any selection in any of the plurality of application programs" from Claims 1, 11 and 25 and "prior to any user selection after opening any of a plurality of application programs ... prior to any user selection with regard to the first or second application programs," from Claim 14. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for exclusion. MPEP 2173.05(i).

Not only are these limitation not supported within the specification, they contradict the very teachings of the invention. The state of the application program is show in the specification to constitute a field in focus or user textual input. In order for a field to be in focus it must be selected. The specification states "For example, the application can communicate state information corresponding to a field identifier, whereby the software input method manager can select an appropriate input method for that field. Note that this can be when the field initially receives focus, or can be at some other time, such as when a user has entered a certain character or string."(pg. 4 lines 9-14). According to the amended claims the input method is selected based on the application program state before any user selection but how can the invention predict the input panel based upon the application program state if the application program state has not been determined yet?

6. Accordingly, the claims have not been further treated on the merits.

Response to Arguments

7. The examiner disagrees with sections cited by the applicant to show support for the claim amendments.

In response the applicant's citation of Paragraph 9 to show support, the examiner disagrees. Par. 9 does teach the input panel can be changed based on what the user is "likely to need based for a given application's state", however the state still needs to be determined and as seen above and in the specification, the state is the field selected to be in focus. Similar arguments apply to Paragraph 39, the state is determined before the automatic step takes place.

In response the applicant's citation of Paragraph 57 to show support, the examiner disagrees. It doesn't matter if the state is determined from the application program or an external source, the state is created by the user selection of a field, thereby making the field in focus.

In response the applicant's citation of Paragraph 64 to show support, the examiner disagrees. The "best guess" is determined based on the state, the state being field in focus.

In response the applicant's citation of Paragraph 66 to show support, the examiner disagrees. The state is first determined, then a check is made to see if a panel exists, if the panel isn't around, then the automatic selection step begins. Note: the state must be determined first. Similar arguments apply to Figure 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

smh


WEILUN LO
SUPERVISORY PATENT EXAMINER